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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/846,889	05/01/2001	Thomas P. Feist	08CN08803C	5322

23413 7590 12/04/2003

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EXAMINER

BERNATZ, KEVIN M

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 12/04/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

cl 17

Advisory Action

Application No.

09/846,889

Applicant(s)

FEIST ET AL.

Examiner

Kevin M Bernatz

Art Unit

1773

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 November 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
(a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.

Claim(s) objected to: none.

Claim(s) rejected: 1-60.

Claim(s) withdrawn from consideration: none.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.

9. ☒ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). 11,12.

10. ☐ Other: _____

Continuation of 2. NOTE: the new claim limitation "comprising at least one plastic resin portion disposed between at least one data layer and a substrate" was not previously required and would require further consideration and/or search. I.e. the previous claims were broader than the proposed amendment and did not require the specific structural location of the plastic resin portion.

The Examiner notes that the amendment to the Title has been entered.

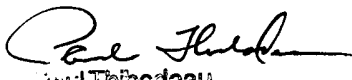
Continuation of 5. does NOT place the application in condition for allowance because: applicants' arguments are directed to the unentered amendment. In so far as they apply to the present rejections of record, applicants argue that improved properties are not "cause effective variables" and that the claimed properties are not necessarily present in the cited prior art. The Examiner respectfully disagrees.

The Examiner notes that the prior art recognizes all of the claimed properties as known properties of recording media (as evidenced in the cited prior art of record). In addition, many teachings have been cited to illustrate that the prior art recognized that certain ranges, minimums or maximums of the various properties are desired. It is this knowledge that (a) the property exists and (b) what values are desired that determines whether a variable is "cause effective". Since the prior art teachings meet both (a) and (b) above, the Examiner deems that applicants are merely claiming optimizations of properties that are known in the art, specifically optimization to values that are recognized as preferred in the prior art. Applicants have presented no experimental evidence that the closest prior art (as exemplified by the cited prior art of record) would be incapable of obtaining these properties nor whether said closest prior art would not necessarily possess these properties ("inherency" is representative of a 102-type rejection while the present rejections are all under 35 U.S.C. 103). Comparison against non-cited art that is not deemed the "closest prior art" is not convincing.

Applicants further argue that the areal recording density is solely a function of the media and conveys structural limitations. The Examiner respectfully disagrees.

The areal recording density, as stated by applicants on page 13 of the afterfinal response, "refers to the amount of data that can be stored in a given amount of hard disk platter "real estate"". This amount of data is strongly dependent on how the data is written, specifically the type of head used, the spacing of the head, etc. All this effects the size of the recording bits, which effects the bits/track, which effects the total bits (tracks/area), i.e. the "recording density".

Krb
12/1/03


Paul Thibodeau
Supervisory Patent Examiner
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